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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,575	08/06/2002	Sydney Gordon Low	DAV1147.001APC	1720

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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER

CORRIELUS, JEAN M

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 09/17/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/009,575

Applicant(s)

LOW ET AL.

Examiner

Jean M Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. This office action is in response the preliminary amendment filed on November 9, 2001, in which claims 1-18 are canceled and claims 19-36 are added.

### ***Information Disclosure Statement***

2. The information disclosure statement (IS) filed on January 23, 2002 and April 08, 2003 complies with the provisions of M.E.P.. § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits. (See attached form).

### ***Drawings***

3. Applicants are required to furnish the formal drawings in response this office action. No new matter may be introduced in the required drawing. Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

### ***Claim Rejections - 35 U.S.C. § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieterman US Patent no. 6,393,464 in view of Scheussler et al., (hereinafter "Scheussler") US Patent no. 6,366,950. As to claim 19, Dieterman disclose an analogous system that provides a method for controlling the delivery of electronic mail messages. In particular, Dieterman discloses the claimed "determining if a message is approved for a recipient of the message" as a means for comparing the identities appearing on the allowed list to determine whether each designated recipient is on the list for the intended recipient that is stored on the database of the e-mail manager (col.5, lines 1-23); and "processing the message for subsequent viewing by the recipient if the message is approved" (col.5, lines 1-66, col.6, lines 2-27). Dieterman does not explicitly disclose the use of notifying the recipient and storing the message if the message is unapproved. Scheussler discloses an analogous system that provides a method for verifying user's identity in a network using E-mail communications. In particular, Scheussler discloses the use of a lookup of the ID number, which is generally triggered by an event when a computer receives an E-mail

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message, said lookup procedure starts, wherein users can define if a notification of the requested lookup shall occur or if a recording or display of the lookup is desired. Scheussler states that users can define how E-mail from computers whose ID numbers are not stored in the database need to be treated, depending on user-specified settings of the computer, E-mail from unauthorized or unidentified computer can be (col.6, lines 57-67). Scheussler also states that users can create a contact list in which all authorized users are listed (col.7, lines 2-5). These implications disclose the claimed “notifying the recipient and storing the message if the message is unapproved”.

Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references. One having ordinary skill in the art would have been motivated to utilize the teachings of Scheussler into the system disclosed by Dieterman because that would Dieterman’s system the enhanced capability of preventing the user from receiving undesired E-mail from individuals.

As to claim 20, Dieterman discloses the claimed “allowing the recipient to view an unapproved message” (col.5, lines 1-66, col.6, lines 2-27)

As to claim 21, Dieterman does not explicitly disclose the claimed “notifying the recipient with a notification message having a link to network data representing a list of unapproved”.

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Scheussler, on the other hand, discloses the use of a lookup of the ID number, which is generally triggered by an event when a computer receives an E-mail message, said lookup procedure starts, wherein users can define if a notification of the requested lookup shall occur or if a recording or display of the lookup is desired. Scheussler states that users can define how E-mail from computers whose ID numbers are not stored in the database need to be treated, depending on user-specified settings of the computer, E-mail from unauthorized or unidentified computer can be (col.6, lines 57-67). Scheussler also states that users can create a contact list in which all authorized users are listed (col.7, lines 2-5). These implications disclose the claimed “notifying the recipient with a notification message having a link to network data representing a list of unapproved”. Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references. One having ordinary skill in the art would have been motivated to utilize the teachings of Scheussler into the system disclosed by Dieterman because that would Dieterman’s system the enhanced capability of preventing the user from receiving undesired E-mail from individuals.

As to claim 22, Dieterman discloses the claimed “wherein the network data comprises markup language data accessible by a computer device of the recipient” (col.5, lines 1-66, col.6, lines 2-27).

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As to claim 23, Dieterman discloses the claimed “allowing the recipient to set criteria to determine if the message is approved” (col.5, lines 1-66, col.6, lines 2-27).

As to claim 24, Dieterman discloses the claimed “wherein the criteria includes a sender of the message being on a stored approved list for the recipient” (col.5, lines 1-66, col.6, lines 2-27).

As to claim 25, Dieterman discloses the claimed “allowing the recipient to change the criteria” (col.5, lines 1-66, col.6, lines 2-27).

As to claims 26-27, Dieterman does not explicitly disclose the claimed “notifying a sender of the unapproved message of deletion of the unapproved message”.

Scheussler, on the other hand, discloses the use of a lookup of the ID number, which is generally triggered by an event when a computer receives an E-mail message, said lookup procedure starts, wherein users can define if a notification of the requested lookup shall occur or if a recording or display of the lookup is desired. Scheussler states that users can define how E-mail from computers whose ID numbers are not stored in the database need to be treated, depending on user-specified settings of the computer, E-mail from unauthorized or unidentified computer can be (col.6, lines 57-67). Scheussler also states that users can create a contact list in which all authorized users are listed (col.7, lines 2-5). These implications disclose the claimed “notifying a sender of the unapproved message of deletion of the unapproved message”. Therefore, it would

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have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references. One having ordinary skill in the art would have been motivated to utilize the teachings of Scheussler into the system disclosed by Dieterman because that would Dieterman's system the enhanced capability of preventing the user from receiving undesired E-mail from individuals.

As to claim 28, Dieterman discloses the claimed "wherein the message and the criteria are stored on an electronic message server" (col.5, lines 1-66, col.6, lines 2-27).

As to claims 29-30 and 36, the limitations of claims 29-30 and 36 have noted in the rejection of claim 19 above. They are, therefore, rejected under the same rationale.

As to claim 31, Dieterman discloses the claimed "an access server for generating a display page with a list of unapproved message (col.5, lines 1-66, col.6, lines 2-27). However, Dieterman does not disclose whether the notification comprising an electronic message with a link to the display page. Scheussler, on the other hand, discloses the use of a lookup of the ID number, which is generally triggered by an event when a computer receives an E-mail message, said lookup procedure starts, wherein users can define if a notification of the requested lookup shall occur or if a recording or display of the lookup is desired. Scheussler states that users can define how E-mail from computers whose ID numbers are not stored in the database need to be treated,



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depending on user-specified settings of the computer, E-mail from unauthorized or unidentified computer can be (col.6, lines 57-67). Scheussler also states that users can create a contact list in which all authorized users are listed (col.7, lines 2-5). These implications disclose the claimed wherein the notification comprising an electronic message with a link to the display page.

Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references. One having ordinary skill in the art would have been motivated to utilize the teachings of Scheussler into the system disclosed by Dieterman because that would Dieterman's system the enhanced capability of preventing the user from receiving undesired E-mail from individuals.

As to claim 32, Dieterman discloses the claimed "wherein the list of unapproved messages includes links to the unapproved message respectively and which on selection causes transmission of an unapproved message to a recipient's computer device for viewing by the recipient"(col.5, lines 1-66, col.6, lines 2-27).

As to claim 33, Dieterman discloses the claimed "wherein the criteria includes the sender of a message being on an approved list for the recipient stored on the system"(col.5, lines 1-66, col.6, lines 2-27).

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As to claim 34, Dieterman discloses the claimed “wherein the display page includes a link to at least one display page for displaying and changing the criteria”(col.5, lines 1-66, col.6, lines 2-27).

As to claim 35, Dieterman discloses the claimed “wherein the display page includes a link for changing the criteria”(col.5, lines 1-66, col.6, lines 2-27).

***Conclusion***

6. Any inquiry concerning this communication or early communication from the Examiner should be directed to **Jean M. Corrielus** whose telephone number is (703) 306-3035. The Examiner can normally be reached on the weekdays from 7:00am to 5:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, **Kim Vu**, can be reached on (703)305-4393

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks Washington, D.C. 20231**

**or faxed to:**

**(703) 746-7236**, (for formal communications intended for entry) **Or:**

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(703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive,

Arlington, VA., Sixth Floor (Receptionist).



Jean M. Corrielus

Patent Examiner

September 10, 2003